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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Dahl et al

Serial No.: 10/783,985

Filed: February 19, 2004

For: MULTIMODAL VEHICLE
TRACTION SYSTEM

To: Mail Stop Amendment
Commissioner for Patents
PO Box 1450
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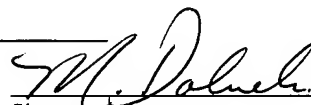
) Attorney Docket: 49593.33.1

) Examiner: K. Hurley

) Group Art Unit: 3611

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Response to Restriction Requirement

This communication responds to the Office Action mailed January 6, 2005 for the application captioned above. In the Office Action, the Examiner classified the claims into four invention groups:

Group I – claims 1-3, drawn to a vehicle, classified in class 475, subclass 237.

Group II – claims 4-21, drawn to a vehicle, classified in class 180, subclass 249.

Group III – claims 22-27, 39, drawn to a vehicle, classified in class 180, subclass 247.

Group IV – claims 28-38, drawn to a vehicle, classified in class 180, subclass 245.

In the Office Action, the Examiner also contended that the four groups comprise unrelated inventions. The Examiner reasoned that the four groups are unrelated since they are not disclosed as being capable of use together since they are each separate vehicles and they have distinct modes of operation. The Examiner also reasoned that the groups have acquired a separate status in the art as shown by their different classification. The Examiner required that Applicant elect a single invention.

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Applicant provisionally elects Group II (claims 4 - 21). Applicant respectfully traverses the restriction requirement and asks that all claims be examined as part of the prosecution of the present application.

MPEP § 808 states that "Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections."

The importance of the first of these requirements is borne out in MPEP § 816 - "The particular reasons relied upon by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. The mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given."

MPEP § 806 summarizes the two general principles under which restriction can be required. Section 806 (A) allows restriction where the groups of claims define independent inventions where there is "no disclosed relation therebetween." Section 806 (B) provides for restriction when the groups of claims are related as disclosed but patentably distinct as claimed.

The present Office Action, while interchangeably using the words independent and distinct, asserts that the groups of claims are independent as in § 806(A) because they are not disclosed as being capable of use together and are separate vehicles that have distinct modes of operation. The Examiner cites MPEP § 806.04 in support of this assertion. MPEP § 806.04 cites two examples of different combinations not capable of use together: "[a]n article of apparel such as a shoe, and a locomotive bearing." and "[a] process of painting a house and a process of boring a well." The Examiner uses form paragraph ¶ 8.20.02 to describe this restriction requirement. The Examiner Note for this paragraph states that "This form paragraph is to be

used only when claims are presented to unrelated inventions, e.g., a necktie and a locomotive bearing.”

The Examiner also cites MPEP § 808.01 which states that where the inventions claimed are not connected in design, operation or effect, “*the facts relied on for this conclusion are in essence the reasons for insisting upon restriction.*” Section 808.01, citing § 806.04, goes on to say that “[t]his situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.”

The sections relied upon by the Examiner simply do not support Examiner’s conclusion that the four groups of claims, each directed towards a motor vehicle having a multimode traction system, the vehicle including a pair of rear wheels, a pair of steerable front wheels, an engine for generating torque to drive the wheels, a differential operatively connected within a drive train and supplying engine torque received from the engine to at least one of the wheels, and a mode switch for selecting the mode of the traction system, define four separate unrelated inventions. These four sets of claims are in no way analogous to claiming a shoe and a locomotive bearing or a house painting process and a well boring process in the same patent application. The only fact relied upon to insist upon restriction of this application to four inventions is that, as claimed, each of the inventions are separate vehicles. This does not meet the requirement of MPEP § 806 (A) that there be “no disclosed relation therebetween.” This is clearly not one of the rare circumstances where MPEP § 808.01 can be appropriately applied to restrict this application to four separate inventions.

The second reason cited by the Examiner for this restriction requirement is that the inventions have acquired a separate status in the art as shown by their different classification. Classification can be used as evidence that related inventions are patentably distinct as in MPEP § 806 (B). MPEP §808.02. However, the Examiner’s use of classification to attempt to show

that groups of claims are unrelated as in MPEP § 806(A) is not supported by the MPEP. Many inventions fall into more than one classification or subclass of the patent classification system. The Examiner claims that Group I is drawn to a vehicle classified as having differential planetary gearing and a manual actuator, Group II is classified as being drawn to a vehicle having four wheels driven and means for locking up the differential, Group III is drawn to a vehicle having four wheels driven with manually operated means for disengaging drive to one or more, but fewer than all, of the four wheels and Group IV is drawn to a vehicle classified as including separate mechanical assemblies for transmitting drive to each of the two wheels at one end of the vehicle. A single vehicle, let alone a single invention, could fall into all of these classifications. The fact that separate groups of claims can be classified in different subclasses within the class of motor vehicles or the related class of planetary gear transmission systems usable in motor vehicles does not mean that those groups of claims constitute independent unrelated inventions. The Examiner has merely shown that the claims could arguably be classified in different classes or subclasses, although very related classes and subclasses. This does not support the required conclusion that there be no disclosed relation between the groups of claims.

Examination of these "groups" of claims would not require additional search or impose significant burden on the Office and would facilitate prosecution of this application. In light of the above, applicant respectfully submits that the present restriction requirement does not meet the Patent Office's standards and expects the requirement to be withdrawn. In the event this requirement is maintained, applicant requests that the Examiner state both the reasons the Examiner believes the restriction is proper and the reasons for requiring restriction, as dictated by the Patent Office's rules. The Examiner is encouraged to telephone the undersigned in order to discuss this matter and these reasons before deciding to maintain the restriction.

Please treat any communication filed at any time in this application, requiring a Petition for an Extension of Time Under 37 CFR 1.136(a) towards timely submission as incorporating a proper petition for an extension of the appropriate length of time. If any additional fees are required to enter the present response, Applicant hereby authorizes the Office to charge our deposit account, Deposit Account No. 061910. If the Examiner feels prosecution of the present application can be materially advanced by a telephonic interview, the undersigned would welcome a call at the number listed below.

Respectfully submitted,

Dated: February 4, 2005

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Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.

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